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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,144	12/17/1999	Jaya Shankar Pathmasuntharan	004404.P002	9823

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EXAMINER
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LE, UYEN CHAU N

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/466,144

Applicant(s)

PATHMASUNTHARAN ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 1 is objected to because of the following informalities:

Re claim 1, line 5: Substitute "first circuitry" with -- the first circuitry --.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-8, 13-15, 29-30, 37-39, and 42-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Teicher et al (US 6,257,486 B1).

Re claims 1-8, 13-15, 29-30, 37-39, and 42-43: Teicher et al discloses a contactless smart card 1150 comprising a radio frequency interface and a keypad 1104 for accepting a personal identification number from a user (figs. 1 & 15B; col. 13, lines 52+ and col. 16, line 51 through

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col. 17, line 5). The smart card 1150 is normally in disable state and only in enable state when the entered PIN is corrected (fig. 12; col. 14, lines 39+).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 9-12, 16-25, 31-35, 40-41, and 44-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teicher et al in view of Feiken (US 6,070,795). The teachings of Teicher et al have been discussed above.

Re claims 9-12, 16-25, 31-35, 40-41, and 44-59: Teicher et al have been discussed above and disclosed the smart card is used as a transaction card (col. 8, line 63 through col. 9, line 33), but fails to teach or fairly suggest specifically the method of creating a transaction value after performing a transaction.

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Feiken teaches the above limitation with the new balance and/or amount of the transaction being stored (figs. 1-5; col. 3, lines 15-35 and col. 4, lines 15+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Feiken into the teachings of Teicher et al in order to provide Teicher et al with a more flexible system wherein old balance and new balance of the card value can be stored and retrieved, and thus providing a more user-friendly system wherein a desired detail transaction record can be retrieved for reviewing at anytime. Furthermore, such modification would have been an obvious extension as taught by Teicher et al, and therefore an obvious expedient.

7. Claims 26-28 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teicher et al as modified by Feiken as applied to claim 35 above, and further in view of Niiyama et al (JP 8-187,346). The teachings of Teicher et al as modified by Feiken have been discussed above.

Re claims 26-28 and 36, Teicher et al/Feiken have been discussed above and Feiken discloses the method of recovery data from an interrupted transaction (col. 5, lines 45+), but fails to teach or fairly suggest the method of recovery data information from the smart card enabler in the event the smart card is lost, damaged or destroyed.

Niiyama et al teaches the above limitation in the English abstract that the data information can be recovered by using part number when the card is damaged.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Niiyama into the teachings of Teicher et al/Feiken in order to provide Teicher et al/Feiken with a more reliable system wherein the data

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information is always stored with a backup version. Furthermore, such modification would have been an obvious extension as taught by Teicher et al/Feiken to provide Teicher et al/Feiken with a more user-friendly system wherein the user does not have to be concerned about losing data when accidentally damaging the card, and therefore an obvious expedient.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Cheung (US 6,062,472); Jonstromer (US 6,142,369); Richards (US 6,164,549); Yoshimura (US 6,126,071); Nakano (US 4,692,601); Takiguchi et al (US 6,352,202); Muller et al (US 6,119,945); Niwata et al (US 6,070,794); Pailles et al (US 5,495,0980); Teicher (US 5,744, 787); Minematsu et al (US 4,864,109); Daggar (US 5,748,737); Cyras et al (US 5,889,866); Dethloff (US 6,047,888); Taylor (US 5,578,808); Eglise et al (US 4,937,436); Furuya et al (JP 11-191,182); and Shishiya (JP 4-314,187) are cited as of interest and illustrate a similar structure to system and method for using a smart card.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M, W, F, Sat. 6:00-2:00 and T & TR 6:00-11:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

*Uyen Chau N. Le*

May 6, 2002

A handwritten signature in black ink, appearing to read 'Thien M. Le', with a stylized, cursive script.

**THIEN M. LE  
PRIMARY EXAMINER**